Remarks

The Rejection of Claims 115-123 and 125-133 Under 35 U.S.C. §103

The Examiner rejected Claims 115-123 and 125-133 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,659,742 (Beattie, at al.) in view of United States Patent No. 5,136,647 (Haber et al.). Applicants have amended Claims 115 and 129 and cancelled Claim 123.

As currently amended, Claims 115 and 129 recite a sequence of receiving a document; posting the document on a day of first publication; and digitally notarizing the product document to create a document notarization record, including a *publication* date/time stamp. The key element of the amendment of Claims 115 and 129 is the *publication* date/time stamp. That is, the present invention produces a digital notarization authenticating the time and date at which a document enters the public domain.

Regarding the requirements for a *prima facie* case of obviousness, Applicants respectfully submit that neither Beattie nor Haber disclose the claimed element of digitally notarizing a product document to create a document notarization record, where the document notarization record includes a *publication* date/time stamp. As stated in Section 4, page 3 of the Office Action, Beattie teaches receiving a document at a server, notarizing said document with an identifier including a date when the document is received, and then posting the document on the Network. Beattie does not link the notarization to a date of *publication.* That is, Beattie can authenticate when a document is received by the server, but can offer no authenticable information regarding the first time the document is made publicly available on the associated network. Haber discloses a method of time-stamping a digital document, but does not disclose the claimed element of digitally notarizing a product document to create a document notarization record, where the document notarization record includes a *publication* date/time stamp.

In accordance with the requirements for a *prima facie* case of obviousness, the references themselves also must suggest a reason to either modify a reference, or the knowledge generally must provide a motivation to modify the references in such a way as to make the claimed invention. However, even if there is a motivation to combine the references, the combined references do not teach the digital notarization of a disclosure as of the date of *publication*. Thus, the combined references do not teach the subject invention.

Beattie is concerned with general data queries and searches to produce textual documents and multi-media files. Beattie makes no mention of notarizing the date when a document is published on the Network and contains no teachings, suggestions, or motivations regarding such date. Simply put, for Beattie, the *publication* date does not matter. The publication date is not relevant to any features, functions, or goals of the Beattie invention. For Beattie, the only date that seems to matter is the date a document was *received*. The Beattie patent uses an example of a typical user query regarding an actor in a TV series and the resultant search produces biographical information and video images. In this example, notarizing the date when a document is *published* on the Network has no value and the *publication* date is of no interest to the administrators or users of the Beattie invention.

Neither does Haber teach, suggest, or motivate digitally notarizing a product document to create a document notarization record, where the document notarization record includes a *publication* date/time stamp.

The present invention is directed to intellectual property matters; specifically with defensive publishing. In particular, with respect to 35 U.S.C. §102(b), the present invention can be used to establish an authenticatible date when a product document enters the public domain and becomes 102(b) prior art. The date of initial *publication* (a necessary component in legal authentication), therefore, is critical. Without establishing an unequivocal date of initial publication, the disclosures cannot be used as prior art. Establishing the date of *receipt* of a document (as in the

case of Beattie), as opposed to the initial date of publication (as in the case of the present invention) is simply not relevant for purposes of defensive publishing. Without an established date of initial *publication* of a disclosure, the document will not withstand scrutiny during prosecution before national patent offices or during civil proceedings. Beattie's system cannot offer any authenticable data regarding defensive publishing since it notarizes at the time of *receipt* and not at the time of *publication.* It could be minutes, hours, days, weeks, or months between the time of receipt of the document and the time of initial *publication.* In fact, it is possible that the document may never be published. The Beattie system fails to provide any notarized proof of *publication* whatsoever.

Hence, Beattie, in view of Haber fails to satisfy the requirements for establishing a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the rejection to Claims 115 and 129 be removed. Claims 116 through 122 and Claims 125 through 128, dependent from Claim 115, also benefit from the above-mentioned distinctions. Claims 130 through 133 dependent from Claim 129 also benefit from the above-mentioned distinctions.

The Rejection of Claim 124 Under 35 U.S.C. §103

The Examiner rejected Claim 124 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,659,742 (Beattie, at al.) in view of United States Patent No. 5,136,647 (Haber et al.) as applied to Claim 115 above, and further in view of United States Patent No. 6,658,453 (Dattatri).

As noted *supra*, the combined teachings of Beattie and Haber fail to satisfy the requirements for establishing a *prima facie* case of obviousness with respect to Claim 115. Neither does adding the teachings of Dattatri establish a *prima facie* case of obviousness with respect to Claim 115. Dattatri fails to teach, suggest, or motivate digitally notarizing a product document to create a document notarization record, where the document notarization record includes a *publication* date/time stamp.

Hence, Beattie, in view of Haber, and further in view of Dattatri fails to satisfy the requirements for establishing a *prima facie* case of obviousness with respect to Claim 115. Claim 124 dependent from Claim 115, also benefits from the above-mentioned distinctions. Therefore, Applicants respectfully request that the rejection to Claim 124 be removed.

Conclusion

The foregoing is submitted as a full and complete Reply to Final Office Action. For all of the reasons set forth above, Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited to contact the undersigned agent of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

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